

3732

Patent
Docket No: 687-456

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Harari et al.

Serial No.: 10/005,760

Filed: November 12, 2000

For: Bone Suturing Device

Group Art Unit: Unknown

Examiner: Unknown



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on:

January 10, 2002
Date

Linda K. Newton
Signature

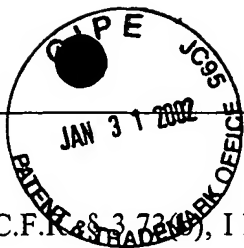
**REVOCATION OF POWER OF ATTORNEY UNDER 37 C.F.R. § 1.36
AND POWER OF ATTORNEY UNDER 37 C.F.R. § 1.34 and CHANGE OF
ADDRESS**

Commissioner for Patents
Washington, DC 20231

Dear Sir:

The undersigned, American Medical Systems International, Inc. is the assignee of the entire right, title, and interest in the above-identified application, as recorded for the parent application in the United States Patent and Trademark Office at Reel 011379, Frame 0772. The assignee hereby revokes all powers of attorney previously given, and appoints the following attorney to prosecute and transact all business in the U.S. Patent and Trademark Office connected therewith: Jeffrey J. Hohenshell, Reg. No. 34,109. The assignee requests that correspondence with respect to this application be directed to:

Jeffrey J. Hohenshell
American Medical Systems
10700 Bren Road West
Minnetonka, Minnesota 55343
Ph: 952 930 6135
Fax: 952 930 6503



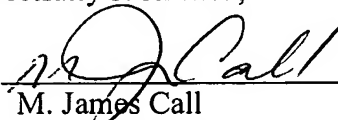
Under 37 C.F.R. § 3.73 (a), I hereby state that I have reviewed the attached recorded assignment and, to the best of my knowledge and belief, title is in American Medical Systems International, Inc.'s name. I am empowered to act American Medical Systems International, Inc.'s behalf in this matter.

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Registration Number	Telephone Number 952 930-6135
Date JAN. 10, 2002	

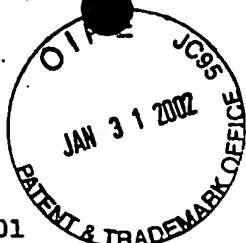
Respectfully submitted,

By



M. James Call
Executive Vice President and CFO

American Medical Systems
10700 Bren Road West
Minnetonka, Minnesota 55343
952 930 6135

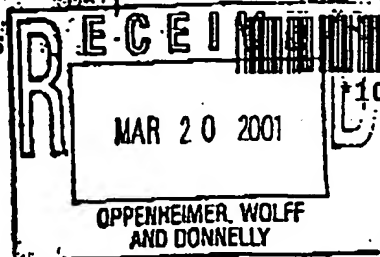


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MARCH 14, 2001

OPPENHEIMER WOLFF & DONNELLY
JAMES W. INSKEEP
500 NEWPORT CENTER DRIVE
SUITE 700
NEWPORT BEACH, CA 92660

PTAS



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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 12/18/2000

REEL/FRAME: 011379/0772

NUMBER OF PAGES: 9

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

INFLUENCE MEDICAL TECHNOLOGIES,
LTD.

DOC DATE: 11/15/2000

ASSIGNEE:

AMERICAN MEDICAL SYSTEMS
INTERNATIONAL, INC.
10700 BREN ROAD WEST
MINNETONKA, MINNESOTA 55343

SERIAL NUMBER: 09422416
PATENT NUMBER:

FILING DATE: 10/21/1999
ISSUE DATE:

SERIAL NUMBER: 09412957
PATENT NUMBER:

FILING DATE: 10/05/1999
ISSUE DATE:

SERIAL NUMBER: 09296735
PATENT NUMBER:

FILING DATE: 04/22/1999
ISSUE DATE:

SERIAL NUMBER: 09287867
PATENT NUMBER:

FILING DATE: 04/07/1999
ISSUE DATE:

011379/0772 PAGE 2

SERIAL NUMBER: 09476682
PATENT NUMBER:

FILING DATE: 12/30/1999
ISSUE DATE:

SERIAL NUMBER: 09475870
PATENT NUMBER:

FILING DATE: 12/30/1999
ISSUE DATE:

SERIAL NUMBER: 08236448
PATENT NUMBER: 5762599

FILING DATE: 05/02/1994
ISSUE DATE: 06/09/1998

SERIAL NUMBER: 08572682
PATENT NUMBER: 5674247

FILING DATE: 12/14/1995
ISSUE DATE: 10/07/1997

SERIAL NUMBER: 08946335
PATENT NUMBER: 5873891

FILING DATE: 10/07/1997
ISSUE DATE: 02/23/1999

SERIAL NUMBER: 08733798
PATENT NUMBER: 5972000

FILING DATE: 10/18/1996
ISSUE DATE: 10/26/1999

SERIAL NUMBER: 08850164
PATENT NUMBER: 6056699

FILING DATE: 05/02/1997
ISSUE DATE: 05/02/2000

DOROTHY BASMA, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

FORM PTO-1595

RECORDATION FORM COVER SHEET

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

PATENTS ONLY

To the Hon. Commissioner of Patents & Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

JAN 31 2002

Influence Medical Technologies, Ltd.

Additional name of conveying party attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name American Medical Systems International, Inc.

Internal Address: _____

Street Address: 10700 Bren Road WestCity: Minnetonka State MN ZIP 55343Additional name(s) and address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other _____Execution Date: November 15, 2000

4. Application number(s) or patent numbers:

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

09/422416 filed 10/21/99

09/412957 filed 10/05/99

09/296735 filed 04/22/99

09/287867 filed 04/07/99

09/476682 filed 12/30/99

09/475870 filed 12/30/99

B. Patent No.(s)

5762599 issued 06/09/98

5674247 issued 10/07/97

5873891 issued 02/23/99

5972000 issued 10/26/99

6056699 issued 05/02/00

Additional numbers attached?

☐ Yes☒ No

5. Name and address party to whom correspondence concerning document should be mailed:

Oppenheimer Wolff & Donnelly
500 Newport Center Drive, Suite 700
Newport Beach, CA 92660

Attn: James W. Inskeep

6. Total number of applications and patents involved: 11

7. Total fee (37 CFR 3.41) \$440.00

☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit Account number:

16-2230

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

James W. Inskeep

Name of Person Signing

Signature

Date

12/8/00

Total number of pages including cover sheet, attachments, and document: 9

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments, Washington, D.C.

OC: 121539 v01

INTELLECTUAL PROPERTY TRANSFER AGREEMENT

THIS INTELLECTUAL PROPERTY TRANSFER AGREEMENT, is made and entered into effective as of November 15, 2000, by and between American Medical System International, Inc., f/k/a Influence, Inc., a Delaware corporation ("AMS International"), and Influence Medical Technologies Ltd., an Israeli company and wholly owned subsidiary of AMS International ("IMT").

A. IMT has conceived and reduced to practice, either actually or constructively, certain inventions that are embodied the patents and patent applications listed on Exhibits A and B.

B. IMT prosecuted and is the record owner of the patents and patent applications listed on Exhibit A.

C. AMS International prosecuted the patents and patent applications listed on Exhibit B in its former name of Influence, Inc. for the benefit of IMT pursuant to the Services Agreement, dated January 1, 1996, between AMS International and IMT.

D. IMT is indebted to AMS International in the amount of \$35,794,714.72 as of October 28, 2000 (the "Indebtedness").

E. IMT desires to assign its interest in the patent and patent applications listed on Exhibits A and B and all related trade secrets, know-how and other proprietary rights to AMS International in consideration for forgiveness of a portion of the Indebtedness.

F. Based on an independent valuations conducted by KPMG LLP and Ernst & Young LLP and other relevant factors, the parties believe the value of the patent and patent applications listed on Exhibits A and B and all related trade secrets, know-how and other proprietary rights is \$23,500,000.

In consideration of the foregoing and the mutual promises and covenants contained herein, the parties agree as follows:

1. Assignment of Intellectual Property Rights. IMT hereby assigns to AMS International all of its right, title and interest in and to (a) the patents and patent applications listed on Exhibits A and B and any patents that issue on such patent applications, including any ancestors, continuations, continuations-in-part, divisionals and reissues thereof and any corresponding foreign patent rights (the "Patent Rights"), and (b) all trade secrets, know-how and other proprietary rights related to the technology associated with the Patent Rights, (all of the foregoing are collectively referred to as the "Intellectual Property Rights"), free and clear of all liens, security interests, claims or other encumbrances of any character whatsoever (collectively "Encumbrances").

2. Recordal of Assignment. Upon the reasonable request of AMS International, IMT agrees to execute the required formal papers necessary to perfect the assignment of rights of Section 1, including but not limited to, the execution of assignment documents in the form required for recordation in the relevant governing office.

3. Purchase Price. In consideration for the assignment of the Intellectual Property Rights, AMS International hereby forgives and forever discharges and releases \$23,500,000 of the Indebtedness:

4. Representation and Warranties of IMT IMT hereby represents and warrants to AMS International as follows:

4.1. Incorporation. IMT is a company duly organized and validly existing under the laws of the State of Israel.

4.2. Valid and Binding Agreement. This Agreement is the valid and legally binding agreement of IMT enforceable against IMT in accordance with its terms, except as may be limited by bankruptcy, insolvency or other laws affecting generally the enforceability of creditors' rights or as may be modified by a court of equity in an action for specific performance or other equitable relief.

4.3. Title. IMT is the sole and exclusive owner of the Intellectual Property Rights, free and clear of all Encumbrances, except to the extent that the Patent Rights listed on Exhibit B are owned of record by Influence, Inc. IMT has not assigned, transferred or granted to any third party any rights to the Intellectual Property Rights.

4.4. No Conflicts. Neither the execution and delivery of this Agreement nor the compliance with the terms and conditions hereof will conflict with, result in a breach or violation by IMT of or constitute a default under any of the terms, conditions or provisions of any contract, agreement or other instrument to which IMT is bound.

5. Representation and Warranties of AMS International. AMS International represents and warrants to IMT as follows:

5.1. Incorporation. AMS International is a corporation duly organized and validly existing under the laws of the State of Delaware.

5.2. Valid and Binding Agreement. This Agreement is the valid and legally binding agreement of AMS International enforceable against AMS International in accordance with its terms, except as may be limited by bankruptcy, insolvency or other laws affecting generally the enforceability of creditors' rights or as may be modified by a court of equity in an action for specific performance or other equitable relief.

5.3. No Conflicts. Neither the execution and delivery of this Agreement nor the compliance with the terms and conditions hereof will conflict with, result in a breach or violation by AMS International of or constitute a default under any of the terms, conditions or provisions of any contract, agreement or other instrument to which AMS International is bound.

6. Miscellaneous.

6.1. Notices. Notices required or permitted hereunder will be in writing and will be sent to the addresses set forth above, by U.S. mail, personal delivery or facsimile and will

be deemed given on the earlier of (a) when delivered to a party, or (b) three days after mailing by prepaid first class mail.

6.2. Validity of Provisions. Severability. If any provision of this Agreement is or becomes or is deemed invalid, illegal or unenforceable in any jurisdiction, (a) such provision will be deemed amended to conform to applicable laws of such jurisdiction so as to be valid and enforceable or, if it cannot be so amended without materially altering the intention of the parties, it will be stricken, (b) the validity, legality and enforceability of such provision will not in any way be affected or impaired thereby in any other jurisdiction, and (c) the remainder of this Agreement will remain in full force and effect.

6.3. Nonwaiver of Rights. No failure or delay on the part of a party in exercising any right hereunder will operate as a waiver of, or impair, any such right. No single or partial exercise of any such right will preclude any other or further exercise thereof or the exercise of any other right. No waiver of any such right will be effective unless given in a signed writing. No waiver of any such right will be deemed a waiver of any other right hereunder.

6.4. Governing Law. This Agreement has been negotiated and entered into in the State of Minnesota, will be deemed to be a Minnesota contract, and will be governed by the laws of Minnesota as to interpretation and performance.

6.5. Counterparts. This Agreement may be executed in any number of counterparts, each of which will be deemed an original and all of which will constitute together but one and the same document.

6.6. Entire Agreement. Modifications. This Agreement including the Exhibits attached hereto sets forth the entire agreement of the parties with respect to the subject matter hereof, all prior and contemporaneous oral and written discussions and understandings are superseded. This Agreement may not be modified except by a writing signed by all parties hereto.

[signature page follows]

IN WITNESS WHEREOF, the parties have executed this Agreement as of the date first written above.

AMERICAN MEDICAL SYSTEMS
INTERNATIONAL, INC.

By: 

Its: Paul and CEO

INFLUENCE MEDICAL TECHNOLOGIES LTD.

By: 

Its: Chief Financial Officer

IMT Patent Schedule
Exhibit A

our docket	country	title	inventor	serial number	filing date	issue number	issue date	Assignment status
368	US	Magnetically-Coupled Implantable Medical Devices (In-flow)	Sohn	08/238448	05/02/1994	5762599	08/09/1998	IMT, Ltd.
370	US	Magnetically-Coupled Implantable Medical Devices (In-flow) (cont. of 687-368)	Sohn	08/422416	10/21/1999			IMT, Ltd.
371	US	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing (In-tac)	Sohn	08/572682	12/14/1995	5874247	10/07/1997	IMT, Ltd.
373	US	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	08/572882	10/07/1997	5873891	02/23/1999	IMT, Ltd.
378	US	Non-Linear Anchor/Staple Insert Device & Bone Anchors (micro-tac, In-tac, staple-tac, In-fast)	Beyar et al.	08/733798	10/18/1998	5972000	10/28/1999	IMT, Ltd.
379	US	Bone Anchor Insert w/Retractable Shield (cont. of 378)	Beyar et al.	08/412957	10/05/1999			IMT, Ltd.
381	US	Apparatus for the Measurement of Urethral Angle Change & Vesical Pressure (US) (In-probe)	Sohn	08/850164	05/02/1997	6058699	05/02/2000	IMT, Ltd.
384	Canada	Implantable Pump & Prosthetic Devices	Sohn	2226170	05/05/1997			IMT, Ltd.
384	Japan	Implantable Pump & Prosthetic Devices	Sohn	09/539713	05/05/1997			IMT, Ltd.
384	PCT	Implantable Pump & Prosthetic Devices	Sohn	PCT/IL97/00415	05/05/1997	WO97/41799	11/13/1997	IMT, Ltd.

IMT Patent Schedule
Exhibit A

385	US	Methods & Apparatus for correction of Urinary & Gynecological Pathologies, including Treatment of Male Incontinence, and Female Cystocele (nexus)	Raz	09/296735	04/22/1999			IMT, Ltd.
387	Israel	Surgical Suture Insertion Device for the Treatment of Urinary Stress Incontinence	Sohn	118617	08/10/1996			IMT, Ltd.
387	PCT	Surgical Suture Insertion Device for the Treatment of Urinary Stress Incontinence - abandoned	Sohn	PCT/IL97/00185	08/10/1997	WO97/47246	12/18/1997	IMT, Ltd.
389	Israel	Adjustable Implantable Artificial sphincter Operated by Remote Control		118271	05/15/1998			IMT, Ltd.
390	US	Medical Sling Procedures & Anchor Insertion Methods & Devices		09/287867	04/07/1999			IMT, Ltd.
393	Israel	Bone Suturing Device	Harari et al	130307	08/07/1999			IMT, Ltd.
393	US	Bone Suturing Device (con. Of IL 130307)	Harari et al	08/476882	12/30/1999			IMT, Ltd.
394	Israel	Tack Device	Harari et al	127978	01/08/1999			IMT, Ltd.
394	PCT	Tack Device	Harari et al	PCT/IL00/00012	01/08/2000			IMT, Ltd.
395	US	Tack Device (continuation of Israeli patent 394) (staple-ic)	Harari et al	09/475870	12/30/1999			IMT, Ltd.
400	US	Balloon Catheter	Sohn	392137	02/22/1995	5549555	08/27/1998	IMT, Ltd.
412	PCT	Bone Suturing Device - No Tac	Harari et al	PCT/IL00/00320	08/04/2000			IMT, Ltd.
412	US	Bone Suturing Device - No Tac	Harari et al					IMT, Ltd.

Influence Patent Schedule
Exhibit B

our docket	country	title	inventor	serial number	filing date	issue number	issue date	Assignment status
368	Australia	Magnetically-Coupled Implantable Medical Devices	Sohn	24646/95	05/02/1995	695987	12/10/1998	Influence, Inc.
368	Canada	Magnetically-Coupled Implantable Medical Devices	Sohn	2189423	05/02/1995			Influence, Inc.
368	EPO	Magnetically-Coupled Implantable Medical Devices	Sohn	95918894.7	05/02/1995	758254		Influence, Inc.
368	Israel	Magnetically-Coupled Implantable Medical Devices	Sohn	113909	05/02/1995			Influence, Inc.
368	Japan	Magnetically-Coupled Implantable Medical Devices	Sohn	07/528473	10/31/1998			Influence, Inc.
368	PCT	Magnetically-Coupled Implantable Medical Devices	Sohn	PCT/US95/05402	05/02/1995	WO95/29718	11/08/1995	Influence, Inc.
371	Canada	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	2207739	12/14/1995			Influence, Inc.
371	EPO	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	95943817.7	12/14/1995	797410		Influence, Inc.
371	Hong Kong	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	989100130.4	12/14/1995			Influence, Inc.
371	Israel	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	111985	12/14/1995	111985	08/30/1999	Influence, Inc.
371	Japan	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	08/519272	06/18/1997			Influence, Inc.

Influence Patent Schedule
Exhibit B

371	PCT	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	PCT/US95/16344	12/14/1995	WO86/18352	06/20/1996	Influence, Inc.
371	S. Korea	Staple & Thread Assembly Particularly for Use in Power Driven Staplers for Medical Suturing	Sohn	97/074060	06/13/1997	246280		Influence, Inc.
374	Canada	System for Catheter Fixation	Sohn	2207400	12/12/1995			Influence, Inc.
374	EPO	System for Catheter Fixation	Sohn	95943055.3	12/12/1995	797464		Influence, Inc.
374	Hong Kong	System for Catheter Fixation	Sohn	98100129.7	01/07/1998			Influence, Inc.
374	Japan	System for Catheter Fixation	Sohn	8/519216	06/12/1997			Influence, Inc.
374	PCT	System for Catheter Fixation (PCT)	Sohn	PCT/US95/16102	12/12/1995			Influence, Inc.
374	S. Korea	System for Catheter Fixation	Sohn	97-703898	06/11/1997			Influence, Inc.
375	US	System for Catheter Fixation (US) (cont. 2117.008 US) (in- flow)(in-Tac, In-Fast)	Sohn	08/412151	10/05/1999			Influence, Inc.
380	Australia	Non-Linear Anchor Insertion Device & Bone Anchors	Beyar et al.	18643/97	02/21/1997			Influence, Inc.
380	Canada	Non-Linear Anchor Insertion Device & Bone Anchors	Beyar et al.	2247464	02/21/1997			Influence, Inc.
380	EPO	Non-Linear Anchor Insertion Device & Bone Anchors	Beyar et al.	97907714.6	02/21/1997	904015		Influence, Inc.
380	Japan	Non-Linear Anchor Insertion Device & Bone Anchors	Beyar et al.	09-530308	02/21/1997			Influence, Inc.
380	PCT	Non-Linear Anchor Insertion Device & Bone Anchors	Influence	PCT/US97/02638	02/02/1997	WO97/30638	08/28/1997	Influence, Inc.